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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Appl. No : 10/620,038

Applicant : Shimek et al.

Filed : July 15, 2003

Title : Soft Dried Marshmallow and Method of Preparation

TC/A.U. : 1761

Examiner : K. Mahafkey

Docket No. : 6126US

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

PETITION TO WITHDRAW PREMATURE FINAL REJECTION

Sir:

The following is a petition to withdraw a premature final rejection in accordance with C.F.R. § 1.181 and M.P.E.P. § 706.07(c). This petition follows a request for reconsideration of the finality made to the Examiner in a personal interview conducted on March 13, 2007 during which the finality action was maintained.

In particular, the Applicant wishes to petition the finality of the first Office Action following the Request for Continued Examination (RCE) submitted in the above-identified application on January 23, 2007. A Preliminary Amendment accompanied the RCE and included changes to claims 1, 2, 5 and 29-32 which established new claimed inventions. In the first Office Action of February 22, 2007, the Examiner finally rejected all of the pending claims in the application (claims 1-39 and 81).

Initially, it is noted that the Examiner only set forth in the Office Action of February 22, 2007 that the reasons for finality of the first action after the filing of a RCE was that the claims “are drawn to the same invention claimed in the earlier application and could have been finally rejected on the grounds and art of record in the next Office Action if they has been entered in the earlier application.” As set forth in M.P.E.P. § 706.07(b), a new application may only be finally rejected in the first Office Action where (A) the new application is a continuing application of, or a substitute for, an earlier application, and (B) all claims of the new application:

- 1) are drawn to the same invention claimed in the earlier application; and
- 2) would have been properly finally rejected on the grounds and art of record in the next Office Action if they had been entered in the earlier application.

In the present case, limitations where added to at least claims 1 and 5 which had not previously been addressed by the Office. More specifically, claim 1 was amended to recite both the limitation of “a springback factor of a minimum of 20% and up to 50%”, as well as a glass transition temperature of less than “5° C”. Although the springback factor limitation was previously set forth in claim 79 and the glass transition temperature limitation was previously set forth in claim 5, this combination of limitations was never claimed and, correspondingly, addressed by the Examiner. Perhaps most importantly, claim 5 was amended to include the new limitation of a glass transition temperature of less than “-10° C”. This limitation was never previously claimed and represents a significant departure from the prior claimed glass transition temperature and the prior art. As this limitation was not previously presented in any pending claims, nor was the limitation ever addressed by the Examiner, this claim is absolutely not drawn to the same invention claimed in the earlier application, nor was this limitation addressed in the outstanding Office action which just duplicated a prior rejection.

In view of the above, it is respectfully submitted that the finality of the February 22, 2007 Office Action is improper, such that withdrawal of the finality is respectfully requested. The required fee accompanies this petition.

Respectfully submitted,



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Date: April 5, 2007

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PO Box 1450
Alexandria, VA 22313-1450**

Sir:

The below identified communication(s) or document(s) is(are) submitted in the above application or proceeding:

<input type="checkbox"/> Amendment/Response After Final	<input type="checkbox"/> Issue Fee Transmittal
<input checked="" type="checkbox"/> Petition to Withdraw Premature Final Rejection	<input type="checkbox"/> Check in the Amount of <u>\$</u>
<input type="checkbox"/>	<input type="checkbox"/> Assignment
<input type="checkbox"/>	<input type="checkbox"/> Associate Power of Attorney

Please charge Deposit Account Number 07-0900 for any deficiency or surplus in connection with this communication. A duplicate copy of this sheet is provided for use by the Deposit Account Branch.

Respectfully submitted,

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Date April 5, 2007